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REMARKS

The present amendment replies to a Non-Final Office Action dated June 7, 2005. Claims 1-19 are pending in the present application and claims 20-22 have been added herein. In the Final Office Action, the Examiner rejected pending claims 1-5, 9-15, and 19 on various grounds. The Examiner objected to claims 6-8 and 16-18 as depending on rejected claims, but found them allowable if rewritten in independent form. The Applicants respond to each ground of rejection as subsequently recited herein and respectfully requests reconsideration of the present application.

- A. Claims 1, 11, and 19 were rejected under 35 U.S.C. §102(e) as being anticipated by Frank (US 2003/0224840).

The §102(e) rejection of claims 1, 11, and 19 is traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Thus, to warrant the §102(e) rejection of claims 1, 11, and 19, U.S. Patent Application No. 2003/0224840 to Frank, *et al.* (the *Frank* application), must show each and every limitation of independent claims 1, 11, and 19 in as complete detail as contained in the independent claims.

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The *Frank* application fails to disclose, teach, or suggest:

a method for operating a telematics unit within a mobile vehicle communication system including assigning a primary telematics unit identifier to a user account and assigning the primary telematics unit identifier to a mobile handset, as recited in independent claim 1;

a computer readable medium for operating a telematics unit within a mobile vehicle including computer readable code for assigning a primary telematics unit identifier to a user account and computer readable code for assigning the primary telematics unit identifier to a mobile handset, as recited in independent claim 11; or

a system for operating a telematics unit within a mobile vehicle including means for assigning a primary telematics unit identifier to a user account and means for assigning the primary telematics unit identifier to a mobile handset, as recited in independent claim 19.

The *Frank* application fails to disclose a primary telematics unit identifier, i.e., an identifier associated with a telematics unit in a primary vehicle. The *Frank* application discloses mobile radio devices 118, 119 each having a SIM card via which it is possible to perform identification within the mobile phone network. See paragraph [0041]. During initial registration and activation of a call diversion, mutual identification of the telematics device and of the mobile telephone is carried out. See paragraphs [0044]-[0046]. The *Frank* application fails to disclose that any telematics unit is a primary telematics unit, i.e., the telematics unit within the primary vehicle as defined in paragraph [0049] of the present application. Therefore, the *Frank* application cannot disclose a primary telematics unit identifier as recited in independent claims 1, 11, and 19. Withdrawal of the rejection of independent claims 1, 11, and 19 under 35 U.S.C. §102(e) as being anticipated by the *Frank* application is respectfully requested.

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- B. Claims 2-5, 9, 10, and 12-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Frank in view of Witkowski (US 2005/0090279).

The §103(a) rejection of claims 2-5, 9, 10, and 12-15 is traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143. The Applicants respectfully submit that the *Frank* and *Witkowski* applications, alone or in combination, fail to teach or suggest all the claim limitations as required to maintain the obviousness rejection.

Claims 2-5, 9, and 10, and claims 12-15 depend directly or indirectly from independent claims 1 and 11, respectively, and so include all the elements and limitations of their respective independent claims. The *Frank* application fails to teach or suggest a primary telematics unit identifier, as discussed in Section A above. U.S. Patent Application No. 2005/0090279 to Witkowski, *et al.* (the *Witkowski* application) also fails to disclose this limitation. The Applicants therefore respectfully submit that dependent claims 2-5, 9, 10, and 12-15 are allowable over the *Frank* application in view of the *Witkowski* application for at least the same reasons as set forth above with respect to their respective independent claims.

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Regarding claims 2-5 and 12-15, the *Witkowski* application fails to disclose downloading user preferences from the service provider, as recited in claims 2 and 12. The text of the *Witkowski* application related to Figures 10 and 11 discloses downloading personalized information, not user preferences. At paragraphs [0079] and [0080], the *Witkowski* application discloses enabling "personalized" information for the user from an Internet-based information service, such as point of interest information including a wide variety of useful information such as restaurants, shopping, service stations, hospitals and other establishments in the vicinity of the vehicle. At paragraph [0082], the *Witkowski* application discloses downloading various personalized information such as selected financial information (i.e., stock price information), world or local news, traffic information along a specified route of travel, phone directory or personal calendar information, weather information, e-mail, etc. None of this information is a user preference. The *Witkowski* application discloses the vehicle owner could access a manufacturer's website to select the desired operating parameters for the vehicle and that the website could cause the owner's home computer (which is equipped with RF transceiver 10a) to generate an RF signal that is sensed by the vehicle causing the parameters to be stored in a memory device in the vehicle (*see* paragraph [0076]), but the desired operating parameters are transferred from the owner's home computer, not downloaded from the service provider as recited in claims 2 and 12. Claims 3-5 and claims 13-15 depend on claims 2 and 12, respectively, and are allowable over the *Frank* application in view of the *Witkowski* application for at least the same reasons as set forth above with respect to their respective claims 2 and 12.

Regarding claim 4, the Examiner did not indicate where in the *Frank* or *Witkowski* applications the limitations of claim 4 are found. Should the Examiner maintain the rejection of claim 4 the Applicants respectfully request that the Examiner identify where in the references the limitations are to be found.

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Withdrawal of the rejection of claims 2-5, 9, 10, and 12-15 under 35 U.S.C.
§103(a) as being unpatentable over the *Frank* application in view of the *Witkowski*
application is respectfully requested.

C. Claims 20-22 have been added herein.

Claims 20-22 have been added herein to more particularly point out and distinctly
claim the Applicants' invention. Claims 20-22 are allowable over the cited references for
at least the reasons discussed above for their respective independent claims 1, 11, and 19.

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CONCLUSION

Reconsideration of the rejection of claims 1-5, 9-15, and 19 and consideration of claims 20-22 is requested in light of the remarks herein. The Applicants submit that claims 1-22 as set forth fully satisfy the requirements of 35 U.S.C. §§102, 103, and 112. In view of foregoing remarks, favorable consideration and early passage to issue of the present application are respectfully requested.

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Respectfully submitted,
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